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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,147	11/25/2000	Paul Lapstun	NPS018US	4018

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BALMAIN, 2041  
AUSTRALIA

EXAMINER

KAO, CHIH CHENG G

ART UNIT PAPER NUMBER

2882

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

**Office Action Summary**

Application No.

09/722,147

Applicant(s)

LAPSTUN ET AL.

Examiner

Chih-Cheng Glen Kao

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claim 23 is objected to because of the following informalities, which appear to be minor draft errors creating lack of antecedent basis problems: claim 23, line 3, "the human discernable interface". This objection may be obviated by changing the dependency of claim 23 from claim 15 to claim 17. For purposes of examination, the claim will be treated as such. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14, 16, 17, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. (US Patent 6152369) in view of Tsutsumoto et al. (JP 05-040841).

3. With regards to claim 14, Wilz, Sr. et al. discloses a viewing device (Fig. 3 and 15, #28) including at least one sensor (Fig. 3, #20) for sensing coded data on a substrate (Fig. 3, #8) and generating first data based at least partly on the coded data (Fig. 1B1), a transmitter (Fig. 3, #31) for transmitting data based on first data to a computer (Fig. 3, #2), a receiver (Fig. 3, #31) for receiving display data from the computer (Fig. 3, #2), and a display for outputting visual

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information based on display data (Fig. 3, #28) wherein the viewing device is arranged so that the sensor senses data when the viewing device is positioned, in use, at least partly overlapping the substrate (Fig. 3).

However, Wilz, Sr. et al. does not disclose a printer mechanism for printing on a substrate.

Tsutsumoto et al. teaches a printer mechanism for printing on a substrate (Abstract, Constitution).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have the printer of Tsutsumoto et al. with the device of Wilz, Sr. et al., since one would be motivated to have a printer to provide a way of indicating the status of an article as implied from Tsutsumoto et al. (Abstract, Purpose).

4. With regards to claim 16, Wilz, Sr. et al. in view of Tsutsumoto et al. suggests a device as recited above.

However, Wilz, Sr. et al. does not disclose printed data corresponding partly with the display data or visual information.

Tsutsumoto et al. further teaches printed data corresponding partly with the data (Paragraph 003).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have the printed data corresponding partly with data with the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al., since one would be motivated to use this to check the status of an item as implied from Tsutsumoto et al. (Paragraph 003).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have the printed data corresponding partly with display data with the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al., since one would be motivated to have the user be aware of the status of an item as implied from Tsutsumoto et al. (Paragraph 003). For example, if the status of an item is completed, a decoded signal may send a signal to a remote central computer system, which collects data from all scanners, and then sends a signal back to the scanner to tell the user of the status of the item for stamping or not stamping.

5. With regards to claims 17, Wilz, Sr. et al. further discloses visual information corresponding to a human discernable interface on the substrate (Fig. 3, #8, 14, and 28).

6. With regards to claim 23 and 25, Wilz, Sr. et al. further discloses visual information representing an electronic document corresponding to a human discernable interface on the substrate visible to an average unaided eye (Fig. 3).

7. With regards to claim 24, Wilz, Sr. et al. further discloses visual information at least replicating some of the human discernable interface (Fig. 3 and 4).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. in view of Tsutsumoto et al. as applied to claim 14 above, and further in view of Danielson et al. (US Patent 6138915).

Wilz, Sr. et al. in view of Tsutsumoto et al. suggest a device as recited above.

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However, Wilz, Sr. et al. does not disclose a display at least partly overlapping the sensor, such that the sensor is positioned between the display and coded data when the viewing device is in use.

Danielson et al. further discloses the display at least partly overlapping the sensor, such that the sensor is positioned between the display and coded data when the viewing device is in use (Fig. 23 and 36).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have the display, sensor, and data of Danielson et al. with the device of Wilz, Sr. et al. in view of Tsutsumoto et al., since one would be motivated to have this configuration to easily hold a device as implied from Danielson et al. (Figs. 23 and 36). Furthermore, rearranging parts of an invention involves only routine skill in the art. Such a rearrangement would have been an obvious modification.

9. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilz, Sr. et al. in view of Tsutsumoto et al. as applied to claim 14 above, and further in view of Goodwin et al. (US Patent 5900110).

10. With regards to claim 18, Wilz, Sr. et al. in view of Tsutsumoto et al. suggests a device as recited above.

However, Wilz, Sr. et al. does not disclose a user interface and control means to print markings based on user input.

Goodwin et al. further teaches a user interface and control means to print markings based on user input (Fig. 1, #13, and col. 1, lines 43-44).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have user input of Goodwin et al. with the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al., since one would be motivated to incorporate this for better user control and entering what one may want to label as implied from Goodwin et al. (col. 1, lines 39-44).

11. With regards to claim 19, Wilz, Sr. et al. further discloses a touch-sensitive overlay (Fig. 3, #29).

12. With regards to claims 20, the functional recitation that the printer mechanism prints markings on the substrate as a user interacts with a touch-sensitive overlay has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a means for performing the specified function.

13. With regards to claim 21, Wilz, Sr. et al. in view of Tsutsumoto et al. and Goodwin et al. suggest a device as recited above.

However, Wilz, Sr. et al. does not disclose printing after user input.

Goodwin et al. further implies printing after user input (Fig. 1, #13, and col. 1, lines 39-44).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have printing after user input with the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al. and Goodwin et al., since one would be motivated to incorporate this to print a label when the user is finished to have data to be used for printing as implied from Goodwin et al. (col. 1, lines 39-44).

14. With regards to claim 22, Wilz, Sr. et al. in view of Tsutsumoto et al. and Goodwin et al. suggest a device as recited above. Wilz, Sr. et al. further discloses user input uploaded to a computer for downloading data based on uploaded data (col. 18, lines 40-44).

However, Wilz, Sr. et al. does not disclose computer data for printing on the substrate.

Tsutsumoto et al. further teaches computer data for printing on the substrate (Fig. 1(a), #5).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have computer data for printing on the substrate with the suggested device of Wilz, Sr. et al. in view of Tsutsumoto et al. and Goodwin et al., since one would be motivated to incorporate this to provide a means for showing the status of an article as implied from Tsutsumoto et al. (Abstract, Purpose).

### ***Response to Arguments***

15. Applicant's arguments with respect to claims 14-25 have been considered but are moot in view of the new ground(s) of rejection.



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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Cheng Glen Kao whose telephone number is (703) 605-5298. The examiner can normally be reached on M - F (9 am to 5 pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Glick can be reached on (703) 308-4858. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



gk

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